

## REMARKS

The Examiner has continued to object to the drawings, seeking clarification of the number labels. Submitted herewith are proposed revised drawings with the further corrections, incorporating clear reference numbers are circled in red. Upon approval, all such corrections will be attended to by a competent Patent Draftsperson.

Claims 1, 2, 5-7, 8/7, 11/7, and 15/8/7 have been rejected under 35 U.S.C. 112 second paragraph as being indefinite, as the Examiner asserts that the placing of review data on a label which is in turn placed upon gradable material is inconsistent with the language utilized in claim 1. Responsive thereto, Applicant has further amended claim 1 to delete the language that the review data is entered "directly" upon the gradable material; the claims have also been amended to clarify that the gradable material is documentary, as opposed to electronic, in form.

All claims have been rejected as obvious and unpatentable over the combination of Bobrow et al '308 in view of Poor '060 either together or together with other secondary art. Responsive thereto, Applicant requests reconsideration of the rejections and consideration of the further amendment of independent claim 1 which further clarifies the nature of the present invention. Applicant acknowledges that the Examiner has supported the rejections with reference to MPEP § 2144.04 regarding omission of an element. It is respectfully submitted, however, that "obvious to remove" does not allow emasculating of the reference and still requires some basis for the obviousness of the change in view of the reference, rather than hindsight derived from the application under examination.

While Bobrow et al purports to be fully integrated with traditional teaching methodologies which use written materials, the grading and review flow implemented by Bobrow et al is significantly different to the traditional grading methodology, wherein the teacher reviews and grades the original document, placing grading information thereon. The present invention preserves that interaction, allowing the original graded document to both be returned to the student if desired while capturing an image of the graded material for archiving and controlled dissemination as appropriate.

While the Examiner acknowledges that Bobrow et al as modified by Poor does not expressly teach that teacher-generated review data is placed directly upon the collected gradable material, she indicates that Bobrow et al allows printing out of gradable material in an organized fashion for subsequent grading, and contends that it would be obvious to one skilled in the art to eliminate the step of scanning in the student exams to organize the content by questions if such a result is not desired. Applicant's response to such a statement is that such a modification of the teaching of Bobrow et al relies on the hindsight developed by the present invention to support the advisability and obviousness of such a change and fails to appreciate the nature and intent of Bobrow et al.

While Bobrow et al does include teachings of a step wherein test materials can be manually graded, the referenced portion of Bobrow et al must be considered in its full context, wherein the exams are still first scanned and, preparatory to them being provided to the teacher, specific intended procedures are performed on the image, as recited at col. 4, lines 37 *et seq.*

The intended purpose of Bobrow et al is to process the student papers prior to the time they are received by the teacher to automate the grading process.

Bobrow states that “[t]he method of the present invention...would generally be comprised of steps of: generating a printing of first educational material...; providing the first educational material to a student; ...inputting said marked first educational material to a form server; identifying a subsequent course of action based on said student markings....” Bobrow et al, col. 1, lines 38-52 (emphasis added). The whole thrust of Bobrow et al is to create an electronic copy of the educational material as received from the student, before any other action is performed. Thus, in addition to the original documents not being returned to the teacher (but rather a copy printed from the scanned image thereof) the system may add check boxes to assist the teacher in grading or provide indicated spaces for teacher’s comments, or otherwise modify the scanned material. For example, “[t]he teacher can check boxes that are interpreted as ‘provide the following reference link that the student can follow’”, Bobrow et al at col. 10, lines 40 *et seq.* Such notations and indications are clearly not present on the original document provided to the student, but are added by the Bobrow et al process to “assist” the teacher. There is nothing in Bobrow et al which would in any way suggest that returning an unscanned document to the teacher would be of any value; to provide the teacher with the original document, rather than scanning it into the system which is the essence of Bobrow et al, negates the total purpose of Bobrow et al and would not be within the contemplation of one reviewing Bobrow et al, as the total purpose of the reference is to assist in automating the grading system. For the teacher to place a grade on the paper before entry into the Bobrow et al scanning process is the antithesis of Bobrow’s methodology, and it is entirely unreasonable to assert that such a flow would be obvious in view of

Bobrow. Elimination of the scanning step is more than eliminating “a feature” of Bobrow et al. It is a total repudiation of the Bobrow et al system and would not be viewed as “obvious” given the intent and purpose of Bobrow et al.

Authorities for the obviousness of omissions as set forth in MPEP § 2144.04 require that omission would be reasonable and not incompatible with the reference’s teachings.

In Ex parte Wu, 10 USPQ2d 2031 (PTO Bd Apps and Interf 1989) the Board affirmed an obviousness rejection, finding that applicant’s exclusion of certain salts to be obvious. In that case, the reference specifically asserted the value of such salts for fresh water contact; thus it would be reasonable to delete them when fresh water contact is not intended to be contacted. The remaining functionality of the reference, which was identical to that of the application under consideration, was not disturbed.

Here, not first scanning the document, as the Examiner suggests, is fully outside the contemplation of Bobrow et al. If initial scanning is not done, then there remains no purpose to Bobrow et al; the grading assistance, which is the central function of Bobrow’s teaching, becomes superfluous and there is thus no reason to practice the Bobrow et al invention. It is only with the teaching of the current disclosure that an alternative grading flow would be recognized as being functional or feasible.

The other MPEP references cited are not to the contrary. In In re Kohle, 188 USPQ 7 (CCPA 1975) the applicant's deletion of a switch was deemed obvious, since the operation of the referenced devices still required insertion of electrodes into the devices to be tested to activate the references' circuits. Thus, the omission of a switch did not modify the operation of the references in any meaningful way. In In re Lawson, 144 USPQ 347 (CCPA 1965), the deletion of added features for increasing capacity as shown in the cited prior art did not affect the potential usage of the same central frame and tubular transverse axle as claimed in the application for liquid cargo carrying, as the prior art clearly taught such use of a hollow axle. The features dispensed with did not affect the structure or potential use of the axle that remained.

These references may claim that for an omission of an element to be obvious there must be significant remaining features or structure that also exist in the application under review. There is no such relationship between Bobrow et al and the present invention, and Bobrow et al offers no reason or basis for such a deletion.

As the combination of Bobrow et al and Poor do not teach or suggest the invention as recited in claim 1, it and all remaining claims of the application are patentable over the art of record. Reconsideration and withdrawal of the rejections is solicited.

Respectfully submitted,

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**CERTIFICATE UNDER 37 C.F.R. 1.8(a)**

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 18, 2006.

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